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John L. Rogitz Rogitz & Associates Suite 3120 750 B Street San Diego, CA 92101			CHUNG, JASON J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/834,511	KITSUKAWA ET AL.	
	Examiner Jason J. Chung	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 May 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 26-37 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-25 is/are rejected.
- 7) Claim(s) 9 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION*****Response to Arguments***

Applicant's arguments filed 5/12/05 have been fully considered but they are not persuasive. The applicant argues on pages 1-3 of the response that claim 1 has been amended to overcome the prior art of record. In particular, the applicant states on pages 2-3 of the response that, "the content is pushed as it becomes available. Smith et al pushes content ... as opposed to when the content becomes available. The examiner respectfully disagrees with this assertion. The examiner takes a broader interpretation of the claim. "As it becomes available" is a relative limitation. The claim does not specifically recite the time frame for downloading, i.e. 5 milliseconds after it is available, half a second after it is available. Smith discloses downloading the Internet content regarding topics of interest to the system as the content regarding topics of interest becomes available prior to receiving a consumer request for the Internet content for the benefit of conserving memory resources and bandwidth (column 4, line 36-column 5, line 12).

The applicant argues on pages 1-2 of the response that amended claim 15 now overcomes the prior art of record. Specifically, since Smith focuses on automatic caching and because allowing a user to disrupt the caching strategy would frustrate Smith. The examiner respectfully disagrees with this assertion. The Smith reference is merely a teaching to modify Shah-Nazaroff (which teaches user inputs). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant argues on page 3 of the response that newly amended claim 2 now overcomes the prior art of record since in Smith, the user must visit a web site hosting content...cached. The examiner respectfully disagrees with this assertion. On page 6 of the response, the applicant refers to page 13 of the specification for support of the limitation "without the user specifying the topic". More specifically, "divulgng that predictive models can be used to determine topics of interest from things such as demographics". Smith functions in the same fashion as the applicant's own invention since Smith uses the user's selections history as predictive models for determining topics of interest. Smith discloses determining at least one topic of interest for at least one consumer (column 4, line 62-column 5, line 12) without the user specifying the topic (the user does not directly specify the topic of interest, rather, predictive models (based on user selection history) are used to determine topics of interest: column 6, lines 9-19).

Claims 26-36 have been cancelled. The examiner considers claim 37 (dependent on cancelled claim 36) to be cancelled even though the applicant made no acknowledgement to claim 37, but has not provided claim 37 on the new version of the claims. Moreover, the applicant specifically states on page 1 of the response, "Claims 1-25 remain pending".

### *Claim Objections*

Claim 9 is objected to because of the following informalities: claim 9, line 1 states, "The method of Claim 1". The claim dependency does not conform to the originally filed claims on 4/13/01. The examiner interprets claim 9, line 1 to state, "The method of claim 5" in order to conform to the originally filed claims on 4/13/01. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 15, 18-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah-Nazaroff (US Patent # 6,317,881) in view of Smith (US Patent # 6,742,033).

Regarding claim 1, Shah-Nazaroff discloses prompting 130 at least one consumer via the interactive television (column 2, line 62-column 3, line 4 and column 7, line 45) for input regarding topics of interest (column 3, lines 23-32).

Shah-Nazaroff discloses receiving consumer input regarding topics of interest (column 3, lines 48-55).

Shah-Nazaroff discloses transmitting the consumer input to a server 170 (column 3, lines 56-62).

Shah Nazaroff discloses the system 100 receives cable 824, satellite 826, and/or Internet 828 (column 8, line 59-column 9, line 9). Moreover, Shah-Nazaroff discloses downloading Internet content regarding topics of interest to the interactive television (column 4, lines 20-26; downloading: column 7, lines 20-42). However, Shah-Nazaroff is silent to disclosing as content becomes available and prior to receiving a consumer request for content. In analogous art, Smith discloses downloading the Internet content regarding topics of interest to the system as the content regarding topics of interest becomes available prior to receiving a consumer request for

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the Internet content for the benefit of conserving memory resources and bandwidth (column 4, line 36-column 5, line 12). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shah-Nazaroff to have downloading prior to receiving a consumer request for the Internet content as taught by Smith for the benefit of conserving memory resources and bandwidth.

Regarding claim 15, Shah-Nazaroff at least one Web server having Internet content stored therein (Internet: column 8, line 59-column 9, line 9; system 100 “receives input **from any or all of the following sources**”).

Shah-Nazaroff discloses at least one interactive television system server (cable or satellite: column 8, lines 59-65).

Shah-Nazaroff discloses at least one interactive television 802 (column 2, line 62-column 3, line 4 and column 7, line 45), the interactive television receiving Internet content at least from the Web server (column 9, lines 7-9), the interactive television system server including a program for automatically downloading content to the interactive television relevant to topics of interest to at least one consumer (column 4, lines 20-26; downloading topics of interest: column 7, lines 20-42).

Although Shah-Nazaroff discloses based on consumer input (column 2, line 62-column 3, line 4 and column 3, lines 23-32), Shah-Nazaroff fails to disclose regarding user-defined...times of day. In analogous art, Smith discloses regarding user-defined priority levels of topics of interest for different times of day for the benefit of caching content that is of greatest interest to the user (column 4, line 63-column 5, line 12 and column 6, lines 9-18). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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modify Shah-Nazaroff to include regarding user-defined priority levels of topics of interest for different times of day as taught by Smith for the benefit of caching content that is of greatest interest to the user.

Regarding claims 18-19, Shah-Nazaroff has met the limitations in claim 1 rejection.

Regarding claim 20, Shah-Nazaroff discloses prompting 130 at least one consumer via the interactive television for input regarding topics of interest (column 3, lines 23-32). However, Shah-Nazaroff fails to disclose priority of topics of interest. In analogous art, Smith discloses priority of the topics of interest (column 6, lines 9-20) for the benefit of presenting content at the appropriate time of day (column 4, line 63-column 5, line 12). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shah-Nazaroff to have priority of topics of interest as taught by Smith in order to present content at the appropriate time of day.

Regarding claim 21, Shah-Nazaroff in view of Smith discloses logic means for receiving consumer input (Shah-Nazaroff: consumer input) regarding priority of the topics of interest (Smith: priority) and logic means for transmitting the consumer input to a server (Shah-Nazaroff: transmitting).

Regarding claim 22, Smith discloses logic means for determining priority of Internet content relevant to topics of Interest (column 6, lines 9-20) and logic means for downloading content relevant to the topic of interest at least on the priority (column 4, line 62-column 5, line 12).

Regarding claim 23, Shah-Nazaroff discloses logic means for monitoring consumer responses (column 7, lines 10-19) to interactive television system server inquiries to establish at least one consumer interest pattern (column 7, lines 20-42).

Regarding claim 24, Shah-Nazaroff discloses logic means for recording the consumer interest pattern (column 3, lines 5-15).

Regarding claim 25, Shah-Nazaroff discloses logic means for filtering future server queries at least partially based on the consumer interest pattern (profile stored at server: column 3, line 63-column 4, line 19; list including relevant programs column 7, lines 20-42)

2. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Lawler (US Patent # 5,699,107).

Regarding claim 2, Smith discloses determining at least one topic of interest for at least one consumer (column 4, line 62-column 5, line 12) without the user specifying the topic (the user does not directly specify the topic of interest, rather, predictive models (based on user selection history) are used to determine topics of interest: column 6, lines 9-19).

Smith fails to disclose notifying the...topic of interest. In analogous art, Lawler discloses notifying (reminder: column 11, lines 40-67) the consumer via the interactive television regarding content concerning the topic of interest (column 12, lines 35-43). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Smith to notify the...topic of interest as taught by Lawler in order to remind the user that there is content available to their liking.

Regarding claims 3-4, Smith in view of Lawler discloses downloading the Internet content regarding topics of interest to the system prior to receiving a consumer request for the Internet content (Smith: column 4, line 36-column 5, line 12).

3. Claims 5-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Lawler in further view of Shah-Nazaroff.

Regarding claim 5, Smith in view of Lawler fails to disclose prompting the...topic of interest. In analogous art, Shah-Nazaroff discloses prompting 130 the consumer via the interactive television for input regarding topics of interest (column 3, lines 23-32). Accordingly, it would have been obvious to one of ordinary skill in the art at the invention was made to modify Smith in view of Lawler to have prompting the...topic of interest as taught by Shah-Nazaroff so the user can explicitly disclose there preferences.

Regarding claim 6, Shah-Nazaroff has met the limitations in claim 1 rejections.

Regarding claim 7, Shah-Nazaroff discloses the server 170 (claim 1 rejection) is a web server (column 9, lines 7-9).

Regarding claim 8, Shah-Nazaroff discloses the server 170 (claim 1 rejection) is an interactive television server (cable or satellite: column 8, lines 59-65).

Regarding claim 9, Smith in view of Lawler in further view of Shah-Nazaroff discloses prompting the consumer via the interactive television (Shah-Nazaroff: prompting, claim 1 rejection) for input regarding priority of the topics of interest (Smith: column 6, lines 9-20).

Regarding claim 10, Smith in view of Lawler in further view of Shah-Nazaroff discloses receiving consumer input (Shah-Nazaroff: consumer input) regarding priority of topics of

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interest (Smith: priority of topics) and transmitting the consumer input to a server (Shah-Nazaroff: transmitting to server).

Regarding claim 11, Smith discloses determining priority of Internet content relevant to the topics of interest and downloading content relevant to the topic of interest based on the priority (column 6, lines 9-20).

Regarding claim 12, Smith in view of Lawler discloses monitoring consumer responses to interactive television system server (Lawler: column 12, lines 16-21) and establishing at least one consumer interest pattern (Smith: column 4, line 63-column 5, line 12).

Smith in view of Lawler fails to disclose the server inquiring. In analogous art, Shah-Nazaroff discloses a server 170 inquiring for the benefit of generating ratings based on feedback (column 3, lines 5-15). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Smith in view of Lawler to have the server inquiring as taught by Shah-Nazaroff for the benefit of generating ratings based on feedback.

Regarding claim 13, Smith discloses recording 202 the consumer interest pattern (column 7, lines 21-41).

Regarding claim 14, Smith discloses filtering future server queries at least partially based on the consumer interest pattern (column 7, lines 42-61).

4. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah-Nazaroff in view of Smith in further view of Lawler.

Regarding claim 16, Shah-Nazaroff discloses logic means for determining at least one topic of interest for at least one consumer (column 7, lines 10-19 and figure 6)

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Shah-Nazaroff in view of Smith fails to disclose logic means for notifying...topic of interest. In analogous art, Lawler discloses notifying (reminder: column 11, lines 40-67) the consumer via the interactive television regarding content concerning the topic of interest (column 12, lines 35-43). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shah-Nazaroff in view of Smith to include logic means for notifying the...topic of interest as taught by Lawler in order to remind the user that there is content available to their liking.

Regarding claim 17, Shah-Nazaroff discloses logic means for downloading the content to the interactive television (column 7, lines 39-41).

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Chung whose telephone number is (571) 272-7292. The examiner can normally be reached on M-F, 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JJC



CHRIS GRANT  
PRIMARY EXAMINER